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EXAMINER	
NAZARIO GONZALEZ,P	
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CONNOLLY BOVE LODGE & HUTZ LLP
1220 MARKET STREET
PO BOX 2207
WILMINGTON DE 19899

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 13

Application Number: 09/488,037
Filing Date: January 19, 2000
Appellant(s): WINTER ET AL.

Ashley I. Pezzner
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed May 02, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The sole issue is whether Applicants, having failed to narrow the scope of the interference count by filing a motion under 37 CFR § 1.633©(1) during the interference proceedings, are now prevented by the doctrine of interference estoppel from claiming subject matter, which Applicants allege to be patentably distinct, that reads on the lost interference count.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because all the species recited in claim 3 were also recited in claim 3 of U.S. Pat. No. 5,693,836 which was the losing party in the interference No. 104,447. Therefore, claim 3

should be finally disposed in accordance with 37 CFR 1.663. Thus, claims 1 and 2 stand or fall together which Applicants also agree.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected on the basis of interference estoppel under 37 CFR § 1.658©. This rejection is set forth in prior Office Action, Paper No. 3.

(11) Response to Argument

Applicants have presented their arguments in two separate groups: claims 1-2 as Group I and claim 3 as Group II. In the case of Group I, the Examiner agrees with Applicants' description of the subject matter claimed in the Karl Application (now U.S. Pat. No. 6,096,912) and in the amended claims 1-2 of the instant reissue application. Applicants argument in Group I is essentially that the instant amended claims are patentably distinct from the Karl patent and therefore they should also be patentably distinct from the interference count (Interference No. 104,447). The Examiner respectfully disagrees with Applicants' rationale. The instant claims have been rejected on the basis of interference Estelle under 37 CFR § 1.658© because of Applicants failure to present a motion under 37 CFR § 1.633©(1) during the interference proceedings by arguing that the subject matter now presented in the amended instant claims was patentably distinct from the interference count. It is the Examiner's position that such argument

should have been raised during the interference proceedings and not during ex parte proceedings. As stated previously, see Papers No. 8 and 10, the interference count was as follows:

A composition of matter according to claim 1 of Winter,

or

a composition according to claim 1 of Karl.

Winter refers to U.S. Patent No. 5,693,836 and Karl refers to U.S. Application No. 08/642,491 (now U.S. Patent No. 6,096,912). The instant amended claim 1 is a subgenus of claim 1 of Winter which is in essence the interference count. Clearly, the subject matter of the instant amended claim 1 is part of the subject matter lost in the interference No. 104,447. Therefore, having an adverse priority determination in the interference, which encompasses the subject matter of claim 1 of Winter, Applicants are now prevented from presenting claims which includes subject matter of a more limited scope of claim 1 of Winter.

Applicants disagrees with the characterization of the central issue in *In re Kroekel et al.*, 231 U.S.P.Q. 640 (CCPA 1986). Like *Kroekel*, the losing party failed to present arguments *via* a motion to change the scope of the count during the interference resulting in an interference estoppel rejection. Further, the losing party also argued that the subject matter claimed in *ex parte* proceedings was patentably distinct from the interference count as well as the subject matter disclosed by the winning party. Furthermore, Applicants statement that by narrowing the claims Applicants have excluded "the precise subject matter lost" is not correct. The lost count encompasses the subject matter of claim 1 of Winter which contains the subject matter now claimed. Thus, making the central issue in this case strikingly similar to the central issue in *Kroekel.* In *Kroekel*, the court affirmed the interference estoppel rejection.

Applicants argued instead that *Ex parte Deckler*, 21 U.S.P.Q. 2d 1872 (BdPatApp&Int, 1991) is applicable to the facts in this case. The Examiner respectfully disagrees. At page 1875, footnote 2, the Board states "Interference 100613 was an "old" rule interference. We note that the present interference rules were designed to resolve all issues which are or could have been raised between parties in an interference in a single proceeding. See particularly 37 CFR Section 1.658(c) which estops a party from obtaining a claim which could have been added and which would have been designated as corresponding to the lost count. The rule was promulgated with a view toward avoiding post-interference reconsideration in an ex parte environment of issues which were or could have been raised inter partes in an interference." This footnote clearly contradicts applicants argument that the facts in *Deckler* are applicable to the facts of this case. Furthermore, this further supports the Examiner's argument with respect to the interference estoppel rejection of the instant claims. Lastly, Applicants have not rebutted the fact the they failed to present a motion under 37 CFR § 1.633©(1) during the interference proceedings to modify the count. This is important in light of the above footnote. Thus, the Examiner respectfully request that the rejection be sustained.

As for Group II, claim 3, the Examiner argues that this claim should be finally disposed in accordance with 37 CFR 1.663 since the recited species are also recited in claim 3 of U.S. Patent No. 5,693,836 to Winter et al., the losing party of Interference No. 104,447. This argument have not been specifically presented by the Examiner. However in Paper No. 10, page 3, lines 3-4, the Examiner mentions that the species presented in the amended claim 3 where also part of the lost claim 3 of the '836 U.S. patent.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Porfirio Nazario Gonzalez
Primary Examiner
Art Unit 1621

Shailendra Kumar
Primary Patent Examiner
Conferee

PNG
May 17, 2001

CONNOLLY BOVE LODGE & HUTZ LLP
1220 MARKET STREET
PO BOX 2207
WILMINGTON, DE 19899